

REMARKS

I. Claim Rejections under 35 U.S.C. § 103

Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the non-patent literature, “What’s My Name”, in view of Rowley (U.S. Patent No. 5,765,875). For the reasons set forth below, Applicant respectfully disagrees and requests the Examiner to reconsider this rejection.

A. The Examiner has failed to make a prima facie case for obviousness.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP § 2143 (Emphasis added).

The Examiner has indicated that the only features recited in the claims that “What’s My Name” lacks are: (i) the identification badges having a unique checking marker used in combination with a master list having identical checking markers; and (ii) awarding prizes to those contestants who correctly guess the identity of the famous person on their identification badges. Because there is no suggestion or motivation to combine the aforementioned prior art references, the Examiner has failed to make a prima facie case for obviousness under 35 U.S.C. § 103(a) with regard to the rejected claims.

Rowley discloses an identification system for children traveling as a group under the guidance of a teacher. In that identification system, children wear an identification tag with some type of identifying indicia. The teacher possesses an information sheet

with the corresponding identifying indicia along with additional information related to each child. What's My Name discloses a game which includes slips of paper that are pinned to the back of each participant. The papers contain names of famous men and women and the participant is required to talk with other members of the party in order to gain the appropriate information needed to determine the name of the famous individual. Neither of these references, however, suggests or motivates practicing these methods or using these apparatuses in combination. There is no indication in the What's My Name reference that the identification badges should, or even could, be used in combination with unique checking markers and a master list. In fact, the What's My Name reference actually teaches away from the claimed invention because there is no need to use a master list in the What's My Name game as the other members of the party know the answer and can let the participant know whether his/her guess is correct. Adding these limitations to the game disclosed in What's My Name would not add any benefit to the game, and, therefore, one skilled in the art would be unlikely to make this required combination.

With respect to the second missing limitation, the Examiner indicates that awarding a prize to the winner would have been obvious to a person having ordinary skill in the art. However, the Examiner has not provided any justification besides this conclusory statement. Without citing any prior art or setting forth the knowledge generally available to one of ordinary skill in the art which would motivate a person to make such a combination, the Examiner concludes that it would have been obvious for a person of ordinary skill in the art to add a prize awarding step to the game disclosed in the What's My Name reference. Applicant submits that this conclusion is not based on

the prior art, including generally available knowledge, but is instead based on a hindsight reconstruction, which is a practice that the Federal Circuit has counseled against. *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992) (“The combination of elements from non-analogous sources, in a manner that reconstructs Applicant’s invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant’s invention itself.”).

The Examiner has failed to provide any support that the prior art references, or the knowledge generally available to one of ordinary skill in the art, provide any suggestion or motivation to modify the What’s My Name reference in the manner claimed by the present invention. Rowley discloses an identification system which, according to the Examiner, uses name tags with identification indicia, a unique checking marker, and a master list. However, nowhere does Rowley suggest or motivate that these components could be used within the context of a socializing game. Likewise, What’s My Name is a game played by large groups. However, there is no suggestion or motivation in this reference to use the type of identification system disclosed in Rowley.

Applicant submits that the rejections based on such unsupported statements of inferential knowledge are improper because they fail to make a *prima facie* case of obviousness.

B. The Rowley reference is non-analogous art and cannot support an obviousness rejection.

Applicant further respectfully submits that Rowley is non-analogous art and, therefore, cannot properly support an obviousness rejection of Applicant's claims.

The proper initial factual determination in assessing obviousness of a claimed invention is to identify the scope and content of the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 86 S.Ct. 684, 693-94, 15 L.Ed.2d 545, 148 U.S. P.Q. 459, 467 (1966). The field of the inventor's endeavor and the particular problem with which the inventor was involved are examined to ascertain the proper scope of the prior art. *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881, 45 U.S.P.Q.2d 1977, 1981 (Fed. Cir. 1998).

The determination of whether a reference is from a non-analogous art focuses on two questions: (1) whether the reference is within the field of the inventor's endeavor and, if not, (2) whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Deminski*, 796 F.2d 436, 442, 230 U.S.P.Q. 313, 315 (Fed. Cir. 1986). Applicant's field of endeavor is socializing games. The particular problem that Applicant was addressing was developing a socializing game that would help party attendees interact with one another.

It is clear that the Rowley reference cited by the Examiner is not within the field of Applicant's endeavor. Rowley is directed to a safety system for groups of children and/or other large groups. Specifically, Rowley relates to a system enabling a responsible adult person in charge of a group of individuals to keep track of those individuals when on an excursion of some kind. Rowley Patent Column 1, Lines 6-9.

This identification tag system clearly has no relation whatsoever to socializing games. Therefore, it simply cannot be said that this reference is within the field of Applicant's endeavor.

Furthermore, this reference is not reasonably pertinent to the particular problem being addressed by Applicant. Applicant's efforts were directed to providing a socializing game to help party goers interact at a social function. Rowley does not speak at all to the issue of using an identification badge with a unique checking marker in combination with a master list in the context of a socializing game. The Rowley patent is directed only to the issue of using the tag system for increasing the safety and security of individuals traveling in a group, a concern not addressed or even considered by the Applicant's claimed invention. Therefore, it cannot be said that this patent is pertinent to the particular problem addressed by Applicant.

As further support for the conclusion that the reference cited by the Examiner in the Office Action is drawn to a non-analogous art, Applicant notes that "amusement devices" such as socializing games (Class 273) are classified in a completely different class than are "printed matter" such as the Rowley invention (Class 283). The distinct and separate classification of these items is additional evidence that the cited reference Rowley is neither related nor pertinent to Applicant's claimed invention.

For the above stated reasons, the rejection under 35 U.S.C. §103 in the Office Action is improperly based on non-analogous art and should be removed.

II. The Prior Art Made of Record

Applicant appreciates Examiner's suggestion that the patent to Schlichting (U.S. Patent No. 5,697,618) is considered pertinent to the Applicant's invention but does not anticipate or render such invention obvious.

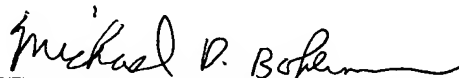
III. Conclusion

Accordingly, Applicant respectfully submits that all of the independent and dependent claims are allowable over the prior art of record.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. If the Examiner disagrees, he is invited to telephone the undersigned at the number provided so that an interview may be scheduled.

Prompt and favorable consideration of this Response is respectfully requested.

Respectfully submitted,



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